



07-13-09

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Assignee : Amity Rubberized Pen Company  
Serial No. : 10/801,194 Patent No.: 7,004,350  
Filed : Mar. 15, 2004 Issued: Feb. 28, 2006  
For : DISPENSER FOR TOOTHPICKS AND TABLETS

PETITION UNDER 37 C.F.R. § 1.182 TO EXPUNGE PAPERS FROM FILE FOR PATENT OFFICE'S FAILURE TO FOLLOW ITS OWN REGULATIONS AND REMOVE UNAUTHORIZED THIRD PARTY SUBMITTALS FROM PATENT FILE AND DISCARD THE UNAUTHORIZED THIRD PARTY SUBMITTALS

Dear Sir/Madam:

Although 37 C.F.R. § 1.59 provides for expungement of papers in an application file, no regulation provides for expungement of papers from the file of an issued patent. Therefore, this petition is filed under 37 C.F.R. § 1.182 for a "question not specifically provided for."

On March 25, 2009 attorney for Assignee (Amity Rubberized Pen Company) contacted the Patent Office to seek the status of Assignee's September 24, 2006 petition to correct inventorship and to enquire about unauthorized third party submittals which had been placed in the Patent File for the subject patent, U.S. Patent No. 7,004,350 ("the '350 Patent"). Mr. Gene Crawford, the supervisory patent examiner for the '350 Patent, indicated that the petition to correct inventorship had never been forwarded to his attention. Within days of calling Mr. Crawford, Assignee obtained a decision on the September 24, 2006 petition to correct inventorship. At the same time, Mr. Crawford indicated that all of the unauthorized third party submittals had been removed from the file for the '350 Patent. I confirmed this news by reviewing the '350 Patent file on the PAIR system on April 12, 2009. On May 11, 2009 I checked the '350 Patent file on the PAIR system and noticed that all of the previously removed third party submittals were inserted back into the file and another third party submittal was filed on April 23, 2009. Today, July 8, 2009, I checked PAIR again and found no change. To date, no

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action has been taken on these prohibited third party submittals, which have no standing under office rules and relevant case law.

The reappearance of these unauthorized third party submittals is a matter of great concern to Assignee. This situation has not been explained and nothing in writing has been posted or sent to Assignee to explain why the Patent Office is not following its own regulations regarding these unauthorized third party submittals. Assignee requests that the Patent Office conduct a full and detailed investigation to determine how, why, and by whom, these documents were placed back in the Patent File, and requests that the Patent Office provide a written notice as to these actions so that proper responses can be made and so that Assignee can direct its questions to the appropriate person at the Patent Office.

As to those unauthorized third party submittals, Assignee respectfully requests again that they be removed from the Patent File and discarded pursuant to 37 C.F.R. § 1.322(a)(2)(ii)( “Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office.”). Assignee respectfully requests that this action be taken immediately and not wait for the outcome of any investigation or written notice.

Those submittals include the following:

1. An “opposition” to Assignee’s petition was filed on or about October 27, 2006 by third party Harris Cohen;
2. A “Supplemental Opposition” filed by the same third party on or about January 31, 2008;
3. A “Petition to Expunge Assignment Records in Issued Patent 7,004,350” filed again by the same third party on or about January 31, 2008;
4. A petition to correct inventorship to seek to add himself as an inventor to Assignee’s patent; and, most recently,

5. That same third party filed on April 23, 2009 a petition to expunge the certificate of correction that was issued for Assignee's patent on March 30, 2009.

All of these third-party documents were filed by Harris Cohen through his attorney, William Breneman. Although these documents do not clearly state on the first page that Mr. Breneman is not representing any of the named inventors or the assignee, it should be stated here that Mr. Breneman does not, and never has, represented any of the named inventors, the assignee, nor any other entity of record related to the '350 Patent. All of these third-party documents were filed and accepted by the Office and entered into the file of Assignee's issued patent against the office's own regulations. These third party submittals seek relief to which third parties are not entitled.

**Harris Cohen is a Third Party with No Ownership Interest in the '350 Patent**

Harris Cohen is a third party with no ownership interest in Assignee, or Assignee's U.S. Patent No. 7,004,350. Additionally, Mr. Cohen is not an inventor, nor has he ever been named by Assignee or the other inventors as an inventor for Assignee's patent.

Third parties, such as Mr. Cohen, have no standing to demand that the Office issue or refuse to issue a Certificate of Correction. See MPEP 1480 I., 37 C.F.R. § 1.322(a)(2); see also *Hallmark Cards, Inc. v. Lehman*, 959 F. Supp. 539, 543-44, 42 U.S.P.Q.2d 1134, 1138 (D. D.C. 1997); see also *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc.*, 218 F.Supp.2d 1243, 1250-51 (S.D. Cal. 2002) ("Because the alleged infringer is not a necessary party to a claim for correction under § 256, the fact that it does not concur in the decision to correct a patent does not create a correction dispute under § 256."); *FFOC Co. v. Invent A.G.*, 882 F. Supp. 642, 650 (E.D. Mich. 1994).

Third party submittals, such as Mr. Cohen's filings regarding Assignee's patent, are not to be made of record in Assignee's patent file, nor retained by the Office. 37 C.F.R. § 1.322(a)(2)(ii).

Instead of following its own procedures, the Office has made Mr. Cohen's third-party submittals of record in Assignee's patent file. Assignee requests again (after making the same request on March 25, 2009 and on May 15, 2009) that the Office again remove third-party submittals from its patent file, and that this time the Office discard the submittals so that they cannot be simply returned to the file a third time. Additionally, Assignee notes that MPEP §§ 503 and 1480 I. state that the Office will not correspond with third parties on whether the Office intends to issue a Certificate of Correction.

Lastly, Mr. Cohen claims, without authority, that he has standing under 35 U.S.C. 256 to dispute inventorship before the Patent Office. No interference has been announced in this matter. In any case, Mr. Cohen is not a party to any dispute under 35 U.S.C. § 256. *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc.*, 218 F.Supp.2d at 1250-51.

#### **February 24, 2009 Cohen Petition to Correct Inventorship**

Mr. Cohen filed a "Petition to Correct Inventorship in an Issued Patent Pursuant to 37 CFR 1.324 and 35 U.S.C. § 256" on or about February 24, 2009 seeking to have his name added to the inventors listed on Assignee's patent. As stated above, Mr. Cohen is not an inventor for Assignee's patent and he has no ownership rights or title to Assignee's patent. Additionally, his petition does not comply with 35 U.S.C. § 256 nor Office regulations.

35 U.S.C. § 256 requires that the Office may issue a certificate of correction of inventorship on "application of all the parties and assignees." Mr. Cohen's petition fails to even assert agreement by Assignee or the other inventors to his petition.

Mr. Cohen's petition to correct Assignee's patent also violates 37 C.F.R. § 1.324(b)(2) because Mr. Cohen failed to include a statement from the current named inventors, Robert Oroumieh and Mary Lewis, that states agreement to the proposed change in inventorship or stating no disagreement to the

requested change. Mr. Cohen's petition is also defective under 37 C.F.R. § 1.324(b)(3) for failing to include the required statement from the Assignee, Amity Rubberized Pen Company.

Thus, Mr. Cohen's petition to correct inventorship does not comply with the Office's regulations. On April 23, 2009 Mr. Cohen filed a petition to suspend the Office's rules under 37 C.F.R. § 11.3. However, even if Mr. Cohen had standing to submit such a petition, it is defective as 37 C.F.R. § 11.3 does not permit suspension of rules which are a requirement of statute. 35 U.S.C. § 256 requires that Mr. Cohen submit his petition with an "application of all the parties and assignees." Thus, Mr. Cohen cannot obtain suspension or waiver of the Office's regulation in this regard.

Additionally, it is unfair that Assignee is required to submit this petition and pay a fee to direct the Office's attention to the matter of improper third-party submittals when this situation results from the Office's failure to follow its own regulations after Assignee repeatedly informed the Office of this improper situation. Accordingly, Assignee requests that the fee be refunded promptly, along with prompt action on this petition, including removing the five unauthorized third-party submittals from the '350 Patent file, discarding the five unauthorized third-party submittals, not corresponding with third parties regarding the '350 Patent, and issuing a written decision on this petition sufficiently detailing actions taken by the Office.

Finally, and perhaps most importantly, after correcting the '350 Patent file as requested above, Assignee requests that the Office conduct a detailed investigation to determine the following matters:

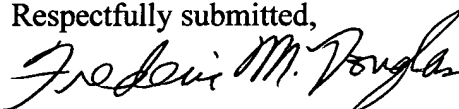
1. The identity of the individual or individuals in the United States Patent and Trademark Office who, in violation of the Office's rules and regulations, filed the documents described above or caused or permitted the filing of those documents;

2. The identity of the individual or individuals in the United States Patent and Trademark Office who, in violation of the Office's rules and regulations, refiled these documents after they had once been withdrawn; and,

3. Determine whether or not any outside party, including any registered patent attorney, suborned the commission of any unlawful or improper acts by any member of the United States Patent and Trademark Office with respect of these filings.

Dated: July 8, 2009

Respectfully submitted,



Frederic M. Douglas

Patent Office Reg. No. 48,813

Attorney of Record for Assignee

(949) 293-0442

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PTO/SB/17p (06-09)

Approved for use through 07/31/2009. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION FEE**  
**Under 37 CFR 1.17(f), (g) & (h)**  
**TRANSMITTAL**  
(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents  
P.O. Box 1450, Alexandria, VA 22313-1450

Application Number	10/801,194
Filing Date	Mar. 15, 2004
First Named Inventor	OROUIMIEH, Robert
Art Unit	3651
Examiner Name	Waggoner, Timothy R.
Attorney Docket Number	AM08-01

Enclosed is a petition filed under 37 CFR 1.182 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 400.00 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(f), see form PTO/SB/17i.

**Payment of Fees** (small entity amounts are NOT available for the petition fees)

☐ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. \_\_\_\_\_:  
☐ petition fee under 37 CFR 1.17(f), (g) or (h) ☐ any deficiency of fees and credit of any overpayments

☒ Check in the amount of \$ 400.00 is enclosed.

☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

**Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462**

For petitions filed under:

- § 1.36(a) - for revocation of a power of attorney by fewer than all applicants
- § 1.53(e) - to accord a filing date.
- § 1.57(a) - to accord a filing date.
- § 1.182 - for decision on a question not specifically provided for.
- § 1.183 - to suspend the rules.
- § 1.378(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

**Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463**

For petitions filed under:

- § 1.12 - for access to an assignment record.
- § 1.14 - for access to an application.
- § 1.47 - for filing by other than all the inventors or a person not the inventor.
- § 1.59 - for expungement of information.
- § 1.103(a) - to suspend action in an application.
- § 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 - for review of refusal to publish a statutory invention registration.
- § 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) - for patent owner requests for extension of time in *ex parte* reexamination proceedings.
- § 1.956 - for patent owner requests for extension of time in *inter partes* reexamination proceedings.
- § 5.12 - for expedited handling of a foreign filing license.
- § 5.15 - for changing the scope of a license.
- § 5.25 - for retroactive license.

**Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464**

For petitions filed under:

- § 1.19(g) - to request documents in a form other than that provided in this part.
- § 1.84 - for accepting color drawings or photographs.
- § 1.91 - for entry of a model or exhibit.
- § 1.102(d) - to make an application special.
- § 1.138(c) - to expressly abandon an application to avoid publication.
- § 1.313 - to withdraw an application from issue.
- § 1.314 - to defer issuance of a patent.

  
Signature

Frederic M. Douglas

Typed or printed name

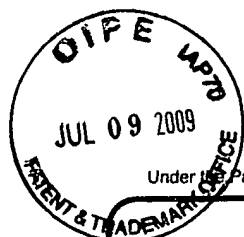
  
Date

48,813

Registration No., if applicable

This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



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First Named Inventor	OROUMIEH, Robert
Art Unit	3651
Examiner Name	Waggoner, Timothy R.
Attorney Docket Number	AM08-01

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